Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CLEMENCE K. DARTEY, and THOMAS E. SOX

Appeal No. 2004-0368
Application No. 09/461,887

ON BRIEF

Before ADAMS, SCHEINER, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-19. Claims 1, 12 and 17 are representative of the subject matter on appeal, and read as follows:

1. A process for preparing a comestible product containing long chain alcohols comprising:

providing a long chain alcohol;

providing an edible oil containing less than about 12 weight percent linolenic acid that is substantially free of medium chain triglycerides composed of C_8 to C_{10} fatty acids;

admixing said long chain alcohol in said edible oil to form a long chain alcohol/edible oil admixture that contains less than two weight percent high molecular weight alcohol, free of an emulsifier, and has a viscosity of less than 200 centipose measured at 70°F; and

combining said admixture with other components of a comestible product.

12. Method for preparing a long chain alcohol in an edible oil material comprising:

providing an edible oil substantially free of medium chain triglycerides composed of C_8-C_{10} triglycerides and containing less than about 10 weight percent linolenic acid;

providing a long chain alcohol;

admixing said edible oil and long chain alcohol in the presence of an energy source such that the long chain alcohol is admixed in the oil; said long chain alcohol/edible oil admixture is stable and free of an emulsifier or surfactant; and having a viscosity of less than about 200 centipose as measured at 70°F.

17. A composition comprising:

a stable edible oil/long chain alcohol admixture substantially free of an emulsifying or surfactant agent, the edible oil substantially free of medium chain triglycerides composed of C_8-C_{10} triglycerides and containing less than about 10 weight percent linolenic acid;

the admixture having a viscosity of less than about 200 centipose as measured at 70°F.

The examiner relies upon the following references:

Cain et al. (Cain) EP 0 901 804 Mar. 17, 1999

Hohnen Oil Co., CAPLUS Abstract, 1986 :18914 (JP 60149367), August 6, 1985.

Kimura et al. (Kimura), CAPLUS Abstract 1994 :321,866 (JP 06024966), February 1, 1994.

Tanaka et al. (Tanaka), CAPLUS Abstract 1989 :153130 (JP 63219357), September 13, 1988.

Claims 1-19 stand rejected over the combination of Cain, Kimura, Hohnen Oil Co. and Tanaka.[1] After careful review of the record and consideration of the issues before us, we reverse.

DISCUSSION

Cain is cited for teaching fat containing products and methods of making the same. See Paper No. 10, page 3. The method of making the fat containing product comprises mixing edible oil with a fatty alcohol having at least 20 carbon atoms, and incorporating the mixture into a food product. Cain is also cited for teaching that the employment of a long chain alcohol in the oil lowers the viscosity of the oil mixture and improves the applicability of the oil mixture in the food process. (page 2, lines 3-58). See id.

[1] We note that the examiner relies solely on the abstracts of Kimura, Tanaka and Hohonen Oil. From our review of the record, it appears that the examiner requested translations of the entire reference, but it does not appear that those translations have been made of record. "Citation of and reliance upon an abstract is generally inappropriate where both the abstract and the underlying document are prior art." MPEP §706.02 (II) (8th edition, Revision 2, May 2004). Moreover, in order for meaningful appellate review to occur, the examiner must present a full and reasoned explanation of the rejection see, e.g., In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002), and that would include analysis of the full underlying document.

The rejection acknowledges that "Cain [ ] does not expressly teach the employment of the particular vegetable oil or the particular food products herein, such as non-continuous oil phase products." Id.

Hohonen Oil and Kimura are cited for teaching "that employment of vegetable oil, such as soybean oil and corn oil for solubilization of fatty acid alcohols is known." Id. Tanaka is cited for teaching "that it is known to employ oil-fatty alcohol mixture for making oil in water emulsion (non-continuous oil phase)." Id.

The rejection concludes:

> Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into non-continuous oil phase mixture.
>
> A person of ordinary skill in the art would have been motivated to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into non-continuous oil phase mixture because the long chain alcohol is known to reduce the viscosity of oils, including those without medium chain glyceride. Using the alcohol-oil mixture taught by Cain to make a particular non-continuous oil phase food products is considered within the skill of artisan, because it is known in the art to employ oil-fatty alcohol mixture for making oil in water emulsion. Further, optimization of the mixing procedure herein, e.g., the temperature, is considered within the skill of artisan. Regarding the limitation of free of an emulsifier or surfactant, it is noted that Cain's claimed subject matter does not require any emulsifier or surfactant. Regarding the particular viscosity in the claimed invention, it is noted that Cain teaches the employment of long chain alcohol herein for reducing the viscosity of edible oil products. See the claims. The difference claimed herein is in degree, not in kind. Such variation is obvious and is within the skill of artisan, absent evidence illustrating the criticality of the difference.

Id. at 3-4.

"A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. To the extent the Patent Office rulings are so supported, there is no basis for resolving doubts against their correctness. Likewise, we may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967.

Appellants argue that the combination of references would not lead to the claimed invention. See Appeal Brief, page 6. Specifically, with respect to the requirement that the composition have a viscosity of less than about 200 centipose (0.2 Pas) as measured at 70°F, appellants contend

> it appears that Cain took viscosity measurement at 50°C (122°F) and 70°C (158°F). The lowest viscosity measurement at 50°C (122°F) using octanosanol in Cain's disclosure was 0.28 Pas, which is not only a temperature over 50 degrees higher than the claimed measurement temperature, but it is also 40% greater viscosity at that higher temperature than that which is explicitly claimed. Further, at 70°C (158°C) [sic, 70°C (158°F)], which is

> more than twice the claimed temperature for measuring viscosity, **Cain discloses** viscosities of 0.2025 and 0.1956 Pas.

Id. at 7 (emphasis in original). Appellants thus conclude that "[t]he secondary references relied upon by the Examiner do not close the gaps left by Cain because they are silent with regard to viscosity." Id.

We agree with the above argument by appellants that the combined references to not teach the claim limitation that the composition have a viscosity of less than about 200 centipose as measured at 70°F.

The examiner argues in response that

> it is noted that Cain teaches the employment of long chain alcohol herein for reducing the viscosity of edible oil products. See the claims. As discussed above, it is obvious to combine the vegetable oil and long chain alcohols. The combined mixture is expected to have low viscosity. The difference claimed herein and those disclosed by Cain [ ] is in degree, not in kind, Such variation is obvious and is within the skill of artisan.

Examiner's Answer, page 5.

As noted by appellants' arguments above, however, Cain teaches higher viscosities at higher temperatures, and the examiner has provided no teaching or suggestion why the ordinary artisan would want to reduce the viscosities taught by Cain. The examiner does argue that it would be obvious to combine vegetable oil with the long chain alcohols to arrive at the claimed invention. Cain teaches the use of long chain alcohols to reduce the viscosity of a confectionary composition such as chocolate. The Tanaka abstract is drawn to an emulsified beverage, the Kimura abstract is drawn to the effect of octacosanol on lipid metabolism, exercise faculty and stress tolerance, and the

Hohnen oil abstract is drawn to an encapsulated health food supplement. The examiner again has not provided any suggestion or motivation of why the ordinary artisan would substitute the vegetable oil of Tanaka, Kimura or Hohnen Oil with the fat used in the confectionary composition of Cain. Therefore, based on the record before us, we are compelled to reverse the rejection of claims 1-19 under 35 U.S.C. § 103(a).

CONCLUSION

Because the examiner has failed to establish a prima facie case of obviousness, the rejection is reversed.

REVERSED

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